

REMARKS

At the outset, the Examiner is thanked for the review and consideration of the pending application. The Non-Final Office Action dated October 16, 2008 has been received and its contents reviewed.

Entry of this Amendment is respectfully requested.

1. Amendments and Support for Same.

By this Response, no claims are hereby amended. No claims are hereby cancelled and no claims are hereby newly added. Claims 15-25 and 32-35 are currently pending.

2. Examiner Interview.

Applicant thanks the Examiner for courtesies extended during a telephone interview on January 13, 2009 with Applicant's representative.

Applicant has not received an Interview Summary as of the date of filing of this Response. Applicant and the Examiner discussed the current claims. No amendments are presently made to the claims to give the Examiner a chance to consider the remarks herein.

3. Request for Reconsideration and Claim 35.

Applicant respectfully requests reconsideration of the Examiner's position regarding the present rejection of the claims.

Furthermore, Applicant notes that the Examiner has not addressed claim 35.

Claim 35 was added per Response of July 1, 2008 and this claim has not been examined by the Examiner.

On page 4 of the Office Action, the Examiner rejects claims 18-20, 25, 32 and 35 as unpatentable over United States patent 6,991,934 (*Walton*) in view of United States patent 6,288,465 (*Suzuki*). However, claim 35 is not rejected in the body of the rejection.

Furthermore, many of Applicant's arguments filed July 1, 2008 have not been addressed by the Examiner.

Accordingly, the next Office Action, if any, must be Non-Final.

4. Claims 15, 21-24 and 33-34 are rejected under 35 U.S.C. §103(a) as unpatentable over United States patent 6,991,934 B2 (*Walton*).

Applicant respectfully requests reconsideration of the Examiner's position with regard to the rejection of claims 15, 21-24 and 33-34.

In rejecting claim 15, the Examiner states, "[a]t the time of the invention, it would have been obvious to a person of ordinary skill in the art to utilize gas and gas discharge ports with the teachings of *Walton*. The suggestion / motivation would have been that fluids include gases and the teachings of *Walton* are not limited to liquids (Office Action at page 3)."

In view of *KSR* it is now clear that a *prima facie* case for obviousness does not require "motivation" in the form of an express teaching in the references themselves. However, *KSR* also stated that the legal conclusion of obviousness requires:

"an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit." [82 USPQ at 1396]

Further, *KSR* cited with approval, 82 USPQ at 1396, the following statement from *In re Khan*, 78 USPQ 1329 (Fed. Cir. 2006):

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Thus, in making a rejection for obviousness, the burden remains on the Examiner to present "articulated reasoning with some rational underpinning" for the combination or modification which bridges the differences between the claimed invention and the prior art.

Applicant maintains that the Examiner has not provided an explicit articulated reasoning with some rational underpinning for modifying *Walton* to accommodate gas and gas discharge ports. Instead, the Examiner has only concluded that, "fluids include gases and the teachings of *Walton* are not limited to liquids."

As best presently understood, there is nothing in *Walton* that teaches gas or gas discharge ports. Furthermore, *Walton* is drawn to a tissue processor for processing biological tissue. *Walton* is not drawn to atomic layer formation. Introduction of gas and gas discharge

ports into the invention of *Walton* may be incompatible with tissue processing. Accordingly, it is submitted that the invention of *Walton* is very different from the claimed invention and the claimed invention is not rendered obvious by *Walton* because the claimed invention has a completely different function from that of *Walton*.

Accordingly, claims 15, 21-24 and 33-34 are believed to be allowable over *Walton*.
Withdrawal of the rejection of claims 15, 21-24 and 33-34 is respectfully requested.

5. Claims 16 and 17 are rejected under 35 U.S.C. §103(a) as unpatentable over *Walton* in view of United States patent application 2003/0079686 A1 (*Chen*).

The rejection of claims 16 and 17 is respectfully traversed and reconsideration is requested. Claims 16 and 17 depend from claim 15 and thus necessarily contain all of the limitations of claim 15.

In the Examiner's Response to Arguments (Office Action at page 6), the Examiner states in regard to claims 16 and 17, "it is obvious to use the disclosed apparatus for reaction gas or purge gas." The Examiner did not address Applicant's arguments of July 1, 2008.

Chen is drawn to a gas delivery apparatus and method for atomic layer deposition. As previously noted, *Walton* is drawn to tissue processing. MPEP §2143.01 states in part, the prior art must suggest the desirability of the claimed invention. It would not be desirable to modify *Walton* in view of *Chen* or to modify *Chen* in view of *Walton* because they are drawn to radically different technologies and processes. Introduction of reactive gases and other gases to tissue preparation in the context of *Walton* would likely render *Walton* unfit for its use. Accordingly, there is no desirability to modify the references.

Accordingly, claims 16 and 17 are believed to be allowable over any combination of *Walton* and *Chen*.

Withdrawal of the rejection of claims 16 and 17 is respectfully requested.

6. Claims 18-20, 25, 32 and 35 are rejected under 35 U.S.C. §103(a) as unpatentable over *Walton* in view of United States patent 6,288,465 (*Suzuki*).

The rejection of claims 18-20, 25 and 32 is respectfully traversed and reconsideration is requested. Claims 18-20, 25 and 32 depend either directly or indirectly from claim 15 and thus necessarily contain all of the limitations of claim 15.

The Examiner did not address Applicant's arguments of July 1, 2008 with respect to the rejections of claims 18-20, 25 and 32.

Furthermore, in *Suzuki* Figure 19, at least an air conduit (48a) is next to a bearing rotor (41a) and orifices (48) surround the bearing rotor (41a). It is respectfully submitted that to modify *Walton* in view of *Suzuki* simply would not work. *Walton* requires a seal in the context of the disc and agitator. Open spaces in *Walton* would disrupt the ability to effectively separate the biological specimens in *Walton* thus rendering *Walton* inoperable.

Accordingly, claims 18-20, 25 and 32 are believed to be allowable over any combination of *Walton* and *Suzuki*.

Withdrawal of the rejection of claims 18-20, 25 and 32 is respectfully requested.

7. Conclusion.

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

Respectfully submitted,
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